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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/931,675	08/15/2001	Yoshifumi Tanimoto	81800.0165	3352
26021	7590	02/07/2005	EXAMINER	
HOGAN & HARTSON L.L.P.			BAKER, CHARLOTTE M	
500 S. GRAND AVENUE			ART UNIT	
SUITE 1900			PAPER NUMBER	
LOS ANGELES, CA 90071-2611			2626	

DATE MAILED: 02/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary**Application No.**

09/931,675

Applicant(s)

TANIMOTO, YOSHIFUMI

Examiner

Charlotte M Baker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>08/15/01, 09/15/03</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Specification

2. The disclosure is objected to because of the following informalities: p. 7, par. 37, replace "flush memory" with "flash memory".

Appropriate correction is required.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shibata et al. (5,909,289) in view of Shibata (5,757,911).

Regarding claim 1: Shibata et al. disclose means for notifying a computer (personal computer 15) of confidential reception (control section 1) when the facsimile apparatus (facsimile apparatus 20) has performed the confidential reception (col. 4, ln. 25-30), said computer being supposed to carry out confidential processing (col. 4, ln. 25-30); and means for transmitting the confidentially received content (control section 1) in accordance with a demand from said computer (personal computer 15) (col. 3, ln. 14-19); facsimile apparatus (facsimile apparatus 20) and said computer (personal computer 15) at the time of carrying out communication with said

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computer (personal computer 15) via a network (communication cable 13) (col. 2, ln. 62-67 through col. 3, ln. 1-5).

Shibata et al. fail to specifically address encryption and decryption by using an encryption key.

Shibata discloses wherein the facsimile apparatus performs encryption and decryption by using an encryption key produced based on peculiar information (col. 3, ln. 20-44).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to incorporate the encryption communication unit 6 disclosed by Shibata (5,757,911) between the control section 1 and the personal computer 15 disclosed by Shibata et al. (5,909,289). The incorporation of the encryption communication unit 6 would provide a way to produce and encryption key and to improve the management of secret encryption keys as suggested by Shibata (5,757,911) (col. 1, ln. 7-10).

Regarding claim 2: Shibata et al. in view of Shibata satisfy all the elements of claim 1. Shibata et al. further disclose from the content to be transmitted to said computer (personal computer 15) which is supposed to carry out confidential processing (col. 4, ln. 25-30).

Shibata et al. fail to specifically address a selecting means for selecting a part to be encrypted by the encryption key.

Shibata discloses selecting means (operation section 10) for selecting a part to be encrypted by the encryption key (col. 4, ln. 1-11); wherein the facsimile apparatus performs encryption in accordance with the selection of the selecting means (operation section 10) (col. 6, ln. 5-23).

Regarding claim 3: Shibata et al. disclose means (facsimile apparatus 20) for carrying out confidential reception (col. 4, ln. 10-31); means for transmitting (control section 1, interface 10, communication cable 13) the confidentially received content as electronic mail (received image data) to a computer (personal computer 15) which is supposed to carry out confidential processing (col. 4, ln. 25-30); facsimile apparatus (facsimile apparatus 20) and said computer (personal computer 15) at the time of carrying out communication with said computer (personal computer 15) via a network (communication cable 13) (col. 2, ln. 62-67 through col. 3, ln. 1-5).

Shibata et al. fail to specifically address encryption and decryption by using an encryption key.

Shibata discloses wherein the facsimile apparatus performs encryption and decryption by using an encryption key produced based on peculiar information (col. 3, ln. 20-44).

Regarding claim 4: Shibata et al. in view of Shibata satisfy all the elements of claim 3.

Arguments analogous to those stated in the rejection of claim 2 are applicable.

Regarding claim 5: Shibata et al. disclose receiving means (facsimile apparatus 20) for receiving facsimile data from a channel (Fig. 1, telephone line); facsimile apparatus (facsimile apparatus 20) and a designated forwarding destination (personal computer 15); forwarding means (control section 1) for forwarding the facsimile data (received image data) to the designated forwarding destination (personal computer 15) via a computer network (communication cable 13).

Shibata et al. fail to specifically address encryption.

Shibata discloses encrypting means (encryption communication unit 6) for encrypting the facsimile data by a common key produced based on peculiar information (col. 3, ln. 20-44).

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Regarding claim 6: Shibata et al. in view of Shibata satisfy all the elements of claim 5.

Shabata et al. further disclose wherein said channel is a telephone line (Fig. 1, telephone line).

Regarding claim 7: Shibata et al. in view of Shibata satisfy all the elements of claim 5. Shibata et al. further disclose wherein said receiving means (facsimile apparatus 20) is capable of carrying out confidential reception (confidential communication function and col. 3, ln. 59-65), and confidential reception of the facsimile data (received image data) is carried out (col. 4, ln. 14-20).

Shibata et al. fail to specifically address encryption.

Shibata discloses the facsimile data is encrypted by said encrypting means (encryption communication unit 6).

Regarding claim 8: Shibata et al. in view of Shibata satisfy all the elements of claim 5. Shibata et al. further disclose wherein said forwarding means (control section 1) utilizes electronic mail protocol (received image data sent to personal computer 15 via a communication cable 13).

Regarding claim 9: Shibata et al. in view of Shibata satisfy all the elements of claim 5. Shibata et al. further disclose wherein said receiving means (facsimile apparatus 20) is capable of carrying out confidential reception (col. 4, ln. 25-30), and when the confidential reception of facsimile data (received image data) is carried out, the facsimile apparatus (facsimile apparatus 20) produces a communication message (facsimile confidential correspondence) to the effect that the confidential reception has been carried out, and transmits the communication message (facsimile confidential correspondence) as electronic mail (received image data) to the designated forwarding destination (personal computer 15) (col. 4, ln. 58-67 through col. 5, ln. 1-8).

Regarding claim 10: Shibata et al. in view of Shibata satisfy all the elements of claim 9.

Shibata further discloses wherein the facsimile apparatus encrypts (encryption communication unit 6) the communication message by using said common key (secret encryption key, col. 3, ln. 20-44).

Regarding claim 11: Shibata et al. in view of Shibata satisfy all the elements of claim 9.

Shibata et al. further discloses wherein when the facsimile apparatus (facsimile apparatus 20) receives, from the designated forwarding destination (personal computer 15), a demand for sending (col. 3, ln. 14-19) of the confidentially received facsimile data after transmitting the communication message (facsimile confidential correspondence), the facsimile apparatus (facsimile apparatus 20) forwards the confidentially received facsimile data (received image data) to the forwarding destination (personal computer 15) (col. 3, ln. 14-19).

Regarding claim 12: Shibata et al. in view of Shibata satisfy all the elements of claim 11.

Shibata et al. further disclose wherein the facsimile apparatus (facsimile apparatus) receives a pass code (password) together with said demand (call-in and col. 3, ln. 14-19) from the designated forwarding destination (personal computer 15), judges whether or not the pass code is correct (confidential mailbox number corresponding to password and col. 3, ln. 30-46), and forwards the confidentially received facsimile data (received image data) to the forwarding destination (personal computer 15) when the pass code is correct.

Regarding claim 13: Shibata et al. in view of Shibata satisfy all the elements of claim 5.

Shibata et al. further disclose facsimile apparatus (facsimile apparatus 20) and the designated forwarding destination (personal computer 15).

Shibata et al. fail to specifically address encryption.

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Shibata discloses further including producing means for producing said common key (secret encryption key) on peculiar information (col. 3, ln. 20-44).

Regarding claim 14: Shibata et al. in view of Shibata satisfy all the elements of claim 5.

Shibata disclose further including selecting means (operation section 10) for selecting a part to be encrypted by said common key (secret encryption key) from the received facsimile data (col. 4, ln. 1-11), wherein the facsimile apparatus encrypts the facsimile data in accordance with the selection of the selecting means (operation section 10) (col. 6, ln. 5-23).

Regarding claim 15: The structural elements of apparatus claim 5 perform all of the steps of method claim 15. Thus, claim 15 is rejected for the same reasons discussed in the rejection of claim 5.

Regarding claim 16: Shibata et al. in view of Shibata satisfy all the elements of claim 15. The structural elements of apparatus claim 6 perform all of the steps of method claim 16. Thus, claim 16 is rejected for the same reasons discussed in the rejection of claim 6.

Regarding claim 17: Shibata et al. in view of Shibata satisfy all the elements of claim 15. The structural elements of apparatus claim 14 perform all of the steps of method claim 17. Thus, claim 17 is rejected for the same reasons discussed in the rejection of claim 14.

Regarding claim 18: Shibata et al. in view of Shibata satisfy all the elements of claim 15. Shibata

further discloses wherein said common key (secret encryption key) is produced by the ID-NIKS system (encryption key table 9a with numbers assigned according to a particular device, col. 3, ln. 29-58). Applicant defines ID-NIKS as an “encryption system which makes use of the ID information specifying address and name of each entity (substance; a person, computer, facsimile server) on p. 8, par. 44. The encryption key table 9a disclosed by Shibata correlates to devices;

therefore, the encryption table 1 reads on the ID-NIKS system.

Regarding claim 19: Shibata et al. disclose program code means (image memory 17) means for making a computer receive facsimile data (received image data) from a channel (Fig. 1, telephone line) (col. 3, ln. 40-46); program code means (image memory 17) for making the computer (personal computer 15) forward to the designated forwarding destination (confidential mailbox) from the receiving side (facsimile apparatus 20) via a computer network (communication cable 13).

Shibata et al. does not specifically address encrypted facsimile data.

Shibata discloses program code means (memory 9) for making the computer produce a common key (secret encryption key) based on peculiar information of a receiving side of the facsimile data and a designated forwarding destination (encryption key table 9a,col. 3, ln. 29-44); program code means (memory 9) for making the computer encrypt said facsimile data (encryption key table 9a) by said common key (secret encryption key); encrypted facsimile data (col. 3, ln. 20-28).

Regarding claim 20: Shibata et al. in view of Shibata satisfy all the elements of claim 19. Shibata et al. further disclose wherein said channel is a telephone line (Fig. 1, telephone line).

Conclusion

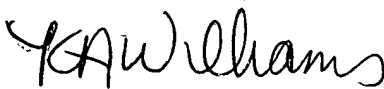
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charlotte M Baker whose telephone number is (703) 306-3456. The examiner can normally be reached on Monday-Friday 8:00-4:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A Williams can be reached on (703) 305-4863. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


cmb


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